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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,426	01/28/1999	FUI-TSENG H. LEE		6073

7590 01/23/2003

FMC CORPORATION  
PATENT ADMINISTRATOR  
INTELLECTUAL PROPERTY LAW DEPARTMENT  
1735 MARKET STREET  
PHILADELPHIA, PA 19103

EXAMINER

CLARDY, S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 01/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/239,426

Applicant(s)  
Lee et al

Examiner  
S. Mark Clardy

Art Unit  
1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 12, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 and 39-49 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 and 39-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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Claims 1-37 and 39-49 are pending in this reissue of US Patent 5,597,780, filed January 28, 1999; the parent patent issued on January 28, 1997.

Applicants are reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,597,780 , which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

Again, the reissue oath/declaration filed on February 22, 2001, is defective because it fails to identify at least one specific error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414 (section II). A reissue oath or declaration must contain the following:

- A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid (in this case, by claiming less than patentee had the right to claim, as stated in the declaration);
- B) A statement of at least one error which is relied upon to support the reissue application, i.e., as the basis for the reissue;
- C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and
- D) The information required by 37 CFR 1.63 (i.e., "reviewed and understand", "original and first inventor", and duty to disclose language).

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Applicants have complied with all but B, above. The "at least one error" statement in the declaration merely restates (A), above: "the patentee claimed less than the patentee had a right to claim." A specific error has not been described. Note MPEP 1414(II), 4th paragraph (in part):

"In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid."

It is not seen that any specific error has been pointed out, much less, how the specific error renders the original patent wholly or partly inoperative or invalid.

Claims 1-37 and 39-49 are again rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 8, 15, 16, 19, 22-42, 48, and 49 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The deletion of the antifoaming agent, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Again, in the specification, the emulsified aqueous phase is disclosed as having an emulsifier, an antifoam agent, and optionally, a xanthan gum viscosity modifier/stabilizer:

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The process of the invention involves the following steps: a) providing an aqueous phase containing an emulsifier, preferably a partially hydrolyzed polyvinyl alcohol; an antifoam agent, and **optionally** a xanthan gum viscosity modifier/stabilizer; ... (col 1, lines 56-60, emphasis added).

The aqueous phase will **ordinarily** contain 0.3 to 3.0, preferably 0.8 to 2.0, weight percent of one or more emulsifiers, e.g., polyvinyl alcohol, 0.05 to 0.20, preferably 0.06 to 0.15, weight percent of the xanthan gum viscosity modifier/stabilizer, **if it is used**, and 0.01 to 1.0, preferably 0.4 to 0.9, weight percent of the antifoam agent. (col 2, lines 16-21, emphasis added).

Also note that the antifoam agent is present in all examples. The xanthan gum component is optional (as is the method step of pH adjustment), and may thus be deleted from the independent claims; however, in view of the clear teachings of the specification, the antifoaming agent is critical and may not be so deleted. Arguably, the punctuation (i.e., semicolon and comma usage) in claim 1 of the patent could be read as indicating that the antifoam agent is optional:

1. A process ... which comprises ... the steps of:
  - a) providing an aqueous phase containing 0.3 to 3.0 wt % of one or more emulsifiers; optionally 0.02 to 0.20 wt % of a xanthan gum viscosity modifier/stabilizer, and 0.1 to 1.0 wt % of an antifoam agent; ...

However, such a reading is in clear contradiction to the teachings of the remainder of the specification; thus the optional material (xanthan gum) ends at the comma, and the antifoaming agent is not optional. It would be inappropriate to rely solely on punctuation as justification to delete subject matter when the preponderance of evidence clearly indicates that it is critical material.

Applicants argue that the embodiments and descriptions which include the antifoam agent do not imply that it **MUST ALWAYS** be present (col 1, lines 56-60, quoted above), and that the description of the aqueous phase as “ordinarily” containing the emulsifier, xanthan gum, and

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antifoam agents also indicates that these are optional components (col 2, lines 16-21, also quoted above). It is not seen that this is a logical conclusion. The xanthan gum is the only component which is described using terms such as "optionally" or "if it is used". Further, if the word "ordinarily" in the above quoted section necessarily implies that all following components are optional, then all components of the composition are optional and the issues under 35USC 112 multiply; note the paragraph following the description of the aqueous phase, quoted above:

The water-immiscible phase will **ordinarily** consist of 60 to 85, preferably 65 to 77, weight percent of clomazone, an amount of polymethylene polyphenyl isocyanate (PMPPI) such that the ratio of clomazone to PMPPI is in the range of 1:1 to 6:1, preferably 4.5:1 to 4.8:1, and an aromatic hydrocarbon solvent for the two solutes. However, use of solvent is optional in the preparation of formulations containing more than about two pounds of clomazone per gallon of formulation. In such preparations a small amount of solvent may still be used to depress the melting point. (Col 2, lines 22-31, emphasis added).

Finally, claim 1 as originally filed was never amended and is thus identical to claim 1 as printed in the patent. There never was, and is not now, **ANY** statement in claim 1 that renders the antifoam optional, as applicant asserts on page 6 of the response. In contradiction to applicants' statement, it is absolutely and unambiguously clear from the specification and claim 1 as originally filed and patented, that the antifoam agent is not optional, but is instead a required component of the claimed composition.

Inasmuch as applicants have deleted essential material from the claims, the claims are now not enabled because the specification does not disclose such compositions.

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Applicants' arguments with respect to the criticality of PVA and hydrocarbon solvents on pages 7 and 8 are persuasive. Thus, the rejections of claims 1, 8, 15-17 and 19-49 (for PVA) and 37-40, 48, and 49 (for solvent) under 35 U.S.C. 112, first paragraph, are withdrawn.

The rejection of claim 37 is under 35 U.S.C. 112, first paragraph, is withdrawn in response to applicants' amendment referring to a polyurea shell.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 8, 15, 16, 19, 22-42, 48, and 49 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The antifoaming agent is an omitted essential element, as noted above.

The rejection of claims 2, 4, 6, and 28 under 35 U.S.C. 112, second paragraph, (no antecedent basis for "the antifoam agent", missing word in claim 28), is withdrawn in response to applicants' amendment.

As discussed in the previous office action, two patents filed subsequent to applicants' earliest filing date pertain to clomazone compositions: Stern et al (US 5,583,090) and its CIP Anderson et al (US 5,783,520), both assigned to Monsanto Co. See Paper No. 11. Again, these references require solvents having a high boiling point ( $>170^{\circ}\text{C}$ ) or which are edible; neither reference discloses the use of an antifoam agent.

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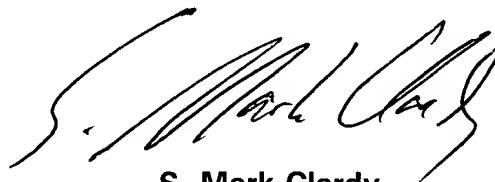
No claim is allowed. Correction of the defective declaration and re-insertion of the antifoam agent into the claims will overcome the rejections of record.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103c and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.



**S. Mark Clardy**  
**Primary Examiner**  
**AU 1616**

January 22, 2003